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| 09/509,637 | 06/02/2000 | KALEVI AHOLA | P08581-US1 | 7880 |

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| EXAMINER |
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BORLINGHAUS, JASON M

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|---|--------------------------------------|--|
| Office Action Summary | Application No. 09/509,637 | Applicant(s) AHOLA, KALEVI | |
| | Examiner JASON M. BORLINGHAUS | Art Unit 3693 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3693

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 21 – 27, 36 – 47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett (US Patent 5,991,748) in view of Wakamoto (US Patent 5,526,415).

Regarding Claim 21, Taskett discloses a method of paying for calls and services paying for calls and services in a telecommunications network (service provider network), comprising the steps of:

- providing database storage for prepaid user (calling card) accounts and for voucher (transaction instrument) accounts, wherein the prepaid user (calling card) account can access the voucher (transaction instrument) account database. (see col. 5, lines 29 – 45);

Art Unit: 3693

- the user purchasing a voucher (prepaid transaction card), wherein the voucher (prepaid transaction card) is a document (card) issued to the user for value received (prepayment). (see col. 3, lines 47 – 54);
- the actual credit value of the voucher (prepaid transaction card) being predefined (prepaid account balance) in the voucher (transaction card) account database (host computer). (see col. 5, lines 29 – 54);
- accessing a network loading service (host computer) through a user interface (calling station) operationally connected to the network, said access occurring in real time during an ongoing call. (see col. 6, lines 45 – 57; col. 7, lines 50 – 65);
- the user validating the voucher by providing voucher identification (credit card number/expiration date) to the network, wherein the network matches the received voucher identification (credit card number/expiration date) with voucher identification (credit card number/expiration date) in the voucher (transaction instrument) database for determining the amount of money stored in a monetary field (current balance) associated with the voucher identification. (see col. 1, lines 47 - 54; col. 6, lines 17 – 36);
- transferring an amount, from the monetary field in the voucher (transaction instrument) database, equal to or less than the voucher (transaction instrument) value (funds), to the user (calling card) account database. (see col. 5, lines 35 – 38; col. 7, lines 30 – 45); and

- charging the calls and services, to the user (calling card) account, according to usage. (see col. 7, lines 53 – 59).

Taskett does not explicitly teach a method wherein the information present on the document is limited to information regarding the voucher account database. (emphasis added). Taskett discloses that information (credit card number/expiration data) present on the card is information contained within the voucher (transaction instrument) account database. Taskett also discloses another document (calling card) wherein the information present is limited to information regarding contacting the account (calling card database). (see fig. 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Taskett by limiting the information on the document to only the information required to perform the transaction, thereby limiting communication of excessive information via the document.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to eliminate information on the document, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Taskett does not teach a method wherein the network is an intelligent network.

Wakamoto discloses that it was old and well known at the time the invention was made that telecommunication networks utilized intelligent networks. (see abstract).

Art Unit: 3693

It would have been obvious to one of ordinary skill at the time the invention was made to have modified Taskett by incorporating an Intelligent Network, as disclosed by Wakamoto, as an intelligent network would allow for efficiencies in telecommunication network management.

Regarding Claim 22, Taskett discloses a method wherein prepaid calls and services are charged to the user account (phone card), the user account (phone card) defining the balance in the account in terms of time or money. (see col. 7, lines 45 - 65).

Taskett does not explicitly teach that the account is defined in terms of pulses. (emphasis added). However, Applicant specification (see p. 11) states that "pulses in the account [are] equal to a certain amount of money" which Examiner interprets to mean that pulses are equivalent to money, as disclosed by Taskett.

Regarding Claim 23, Taskett discloses a method wherein the user accesses the voucher (transaction instrument) record in the voucher database according to the user's number (credit card number/personal identification number). (see col. 1, lines 47 – 54; Claim 5).

Taskett does not explicitly teach a method wherein the user's number is the user's telephone number.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for any personal identification number that the inventor desired, such as the user's telephone number. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Regarding Claims 24 – 25, Taskett discloses a method wherein:

Art Unit: 3693

- utilizing the loading service (host computer) for transferring all or part of the amount (funds) in the voucher record (transaction instrument) to the user account (calling card). (see col. 5, lines 35 – 38); and
- the amount of the voucher in the voucher record is used for transferring money (funds) from a monetary field in the voucher record (fields relating to transaction instrument) to the monetary field in the user account database (fields relating to transaction telephone card. (see col. 7, lines 30 – 44).

Taskett does not explicitly teach a method wherein the voucher record **is used only for** transferring money from the monetary field in the voucher record to the monetary field in the user account database. (emphasis added).

First, Examiner asserts that the recitation of the intended use or purpose of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use or fulfilling said purpose, then it meets the claim. Examiner asserts that Taskett is capable of fulfilling said purpose despite the intended purpose of the claimed function. *Ex parte Masham, 2 USPQ2d 1647 (1987)*.

Second, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have reduced the functionality of Taskett, limiting the transfer of funds between two accounts, since it has been held that omission of an element and its function in a combination where the remaining elements perform the

Art Unit: 3693

same functions as before involves only routine skill in the art. *In re Karlson*, 136 USPQ 184 (CCPA 1963).

Regarding Claim 26, Taskett does not explicitly teach a method further comprising the step of blocking the transfer of a specified amount from the voucher record to the user account. Taskett does disclose a method further comprising transferring a specified amount (\$10, \$20 or \$30) from the voucher record to the user account. (see col. 7, lines 15 - 22). Taskett further discloses that the voucher record has prepaid account balance, thereby limiting the amount that can be transferred from the voucher record. (see col. 3, lines 46 -55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Taskett and Wakamoto to incorporate the step of blocking the transfer of a specified amount (transfer amount in excess of prepaid account balance) from the voucher record to the user record, thereby preventing an overwithdrawal.

Regarding Claim 27, Taskett does not explicitly teach a method wherein the user account records and the voucher account database records are in a common database.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combining the two records residing in two databases into a common database, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Art Unit: 3693

Howard v. Detroit Stove Works, 150 U.S. 164 (1893); *In re Larson, Russler & Meldahl*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965).

Regarding Claim 36, such claims recite substantially similar limitations as claimed in previously rejected claims and, therefore, would have been obvious based upon previously rejected claims or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Regarding Claim 37, Taskett discloses a point (host computer) in the network monitors calls and applies charges to the user account for covered calls or services. (see col. 7, lines 51 – 65).

Taskett does not teach a node wherein a **service control point** in the **intelligent network** monitors calls and applies charges to the user account (emphasis added).

Wakamoto discloses that it was old and well known at the time the invention was made that telecommunication networks utilized intelligent networks and service control points. (see col. 2, line 60 – col. 3, line 7).

It would have been obvious to one of ordinary skill at the time the invention was made to have modified Taskett and Wakamoto by incorporating an intelligent network and service control points, as disclosed by Wakamoto, as such telecommunication components allow for efficiencies in telecommunication network management.

Regarding Claims 38 – 43, such claims recite substantially similar limitations as claimed in previously rejected claims and, therefore, would have been obvious based upon previously rejected claims or are otherwise disclosed by the prior art applied in

Art Unit: 3693

previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Regarding Claim 44, Taskett does not disclose that the loading request is accomplished by a mobile station.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Taskett and Wakamoto to make the station mobile, since it has been held that making an old device or movable without producing any new and unexpected result involves only routine skill in the art. *In re Lindberg*, 93 USPQ 23 (CCPA 1952).

Regarding Claims 45 - 47, Taskett discloses a system wherein:

- the user is prompted to load more balance by announcements to the user via the user interface. (see col. 7, line 66 – col. 8, line 11);
- identifying the user request according to the user's A-number (account code). (see col. 6, lines 58 – 67);
- receiving an identifier (credit card number) and a secret code (expiration date) associated with the voucher (credit card). (see col. 1, lines 47 - 54);
- sending the amount (\$10, \$20 or \$30) to be loaded (regenerated) to the loading service (host computer). (see col. 7, lines 15 – 22);
- sending an announcement to the user interface that the request has been accomplished and notification of the new balance (provide account balance) in the user account. (see col. 7, lines 1 – 14); and

Art Unit: 3693

- the announcement to the user is sent as a text message or as a voice message. (see col. 7, lines 15 – 22).

Regarding Claim 49, Taskett discloses a method wherein the document (transaction instrument) comprises paper (cardboard) or plastic. (see col. 1, lines 14 – 20).

Regarding Claims 50 - 51, such claims recite substantially similar limitations as claimed in previously rejected claims and, therefore, would have been obvious based upon previously rejected claims or are otherwise disclosed by the prior art applied in previously rejected claims. Such claim limitations are therefore rejected using the same art and rationale as previously utilized.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taskett and Wakamoto, as applied to Claim 42 above, and further in view of Tsunokawa (US Patent 5,546,446).

Regarding Claim 48, Taskett discloses a method comprising the steps of setting a time limit for expiration (expiration date) of the validity of the balance of the voucher (credit card).

Taskett does not teach a method wherein expired vouchers are deleted from the record in the database.

Tsunokawa discloses a method wherein expired vouchers (card information) are deleted from the record in the database. (see abstract).

Art Unit: 3693

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Taskett and Wakamoto by incorporating the deletion of expired vouchers from the database, as disclosed by Tsunokawa, thereby eliminating expired and superfluous data from the system.

Response to Arguments

Applicant's arguments filed 3/29/09 have been fully considered but they are not persuasive.

Amendment to Specification

The courts have stated that if there are multiple definitions for a term and a definition is added to the application, it must be clear from the application as filed that applicant intended a particular definition, in order to avoid an issue of new matter and/or lack of written description. See, e.g., *Scarring Corp. v. Megan, Inc.*, 222 F.3d 1347, 1352-53, 55 USPQ2d 1650, 1654 (Fed. Cir. 2000). Examiner accepts, based upon the specification, that a particular definition was intended for the terms A-number and B-number at the time of filing and, therefore, the amendment to the specification filed on 12/08/08 are accepted.

§103 Rejection

Art Unit: 3693

Applicant explains the crux of the Applicant's invention. However, this explanation (even if claimed) fails to differentiate the Applicant's invention from the prior art.

Taskett discloses a prepaid or voucher (transaction instrument) account, such as the account pertaining to a prepaid card, a debit card, an American Express credit card, or other credit card associated with the calling card. (see col. 6, lines 17 - 36). Also disclosed is a user (phone card/calling card) account that provides direct payment for services (telephone services). The prepaid account (transaction instrument) acts as a deposit (funding) account that the user can access when the user (phone card/calling card) is low. (see col. 6, lines 17 – 36).

Applicant asserts that the prior art fails to disclose the claim limitations of amended Claim 1. However, Claim 1 has been cancelled by amendment.

Applicant asserts that the prior art fails to disclose the use of a paper voucher or receipt as in Claim 21. However, Claim 21 claims "the voucher is a document" and dependent Claim 49 claims "wherein the document comprises paper or plastic."

Nonetheless, Taskett discloses "a printed transaction card constructed from plastic or cardboard." (see col. 1, lines 14 – 20). Therefore, Taskett does disclose the use of a paper voucher.

Such response also applies to Applicant's arguments concerning Claims 36 and 42.

Applicant asserts that Tsunokwawa is not pertinent prior art. Based upon the Applicant's arguments, Examiner is uncertain why Tsunokwawa is deemed not relevant.

Art Unit: 3693

Tsunokwawa is being utilized by the Examiner for the sole purpose of establishing that it is old and well known in the art to delete expired vouchers from a database, despite other differences that may exist between Tsunokwawa and the claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3693

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason M Borlinghaus/
Examiner, Art Unit 3693
March 30, 2009